Remarks

Applicants' attorney thanks the Examiner for the telephone conference of 15 October 2003. In the conference, Applicant's attorney noted that the instant 35 U.S.C. §103(a) rejection as well as part of the 35 U.S.C. §112 rejection are copies of 35 U.S.C. §103(a) and 35 U.S.C. §112 rejections that the Examiner mailed on the same day (24 July 2003) in Assignee's application serial no. 09/926,521, and perhaps a copy/paste error had occurred. The Examiner confirmed that there is no error and the rejections apply to both applications. The Examiner suggested that the Applicants respond to the instant Office action and address any inconsistencies in that response.

Applicants acknowledge that claims 1, 2, 33, 34, 40-42, 49, 50, 55, 56, 62, 63, 69, 72, 77, 80-83, 88, 93, 96, 99, 100, 124-127, 131-133 and 137-139 are withdrawn from consideration without prejudice to their patentability and presentation in a continuation application.

Claims 35-39, 43-48, 51-54, 57-61, 64-66, 134-136 and 143-145 are canceled without prejudice to their patentability and presentation in a continuation application.

Claims 3 and 101 are amended into independent format and incorporate the features from the claims from which they formerly depended.

Claims 3 and 101 are amended to require a weight ratio of the surfactant component to the compound of between about 5:1 and about 40:1. Claims 7 and 105 are amended to require a weight ratio of the surfactant component to the compound of between about 5:1 and about 20:1. Those weight ratio ranges are supported by the specification at page 27, lines 16-17.

Claims 7-10 are amended to depend from claim 3. Claims 106 and 107 are amended to depend from claim 101.

Claim 148 is amended to require a glyphosate salt or ester.

Claim 84 is amended to include POE(2)cocoalkyltrimethyl ammonium chlorides which are described at page 6, line 16-19 of the specification.

Upon entry of the amendments claims 3-32, 67, 68, 70, 71, 73-76, 78, 79, 84-87, 89-92, 94, 95, 97, 98, 101-123, 128-130, 140-142 and 146-148 will be pending.

I. Objection under 37 CFR §1.75

Reconsideration is respectfully requested of the objection of claim 5 under 37 CFR §1.75 as being substantial duplicate of claim 4. The claim 4 Markush group includes the isopropylamine ("IPA") salt of glyphosate; the claim 5 Markush group does not include the IPA salt of glyphosate. Applicants maintain that claim 5, which depends from claim 4, is not a substantial duplicate of claim 4 but is a proper dependent claim of reduced scope from the claim from which it depends. The applicants may "...restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough."[1]

II. Rejection under 35 U.S.C. §112, second paragraph

Claims 6, 130 and 135 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 135 is canceled thereby rendering the rejection under 35 U.S.C. §112, second paragraph, moot. As to claim 6, the Office found that the term "may" renders the claim indefinite and the term "said stratum" lacks antecedent basis. As to claim 130, the Office found that the claimed range of 480 to 600 g/l is not within the scope of the range of the parent claim.

Applicants respectfully submit that rejection of claims 6 and 130 was erroneous and improper, and those claims meet the requirements under 35 U.S.C. §112, second paragraph. Applicants note that the instant 35 U.S.C. §112 rejection is a copy of the rejection of claims 6 and 130 issued in the '521 application (see the telephone conference summary above). Instant claim 6 is directed to salts of glyphosate and does not have the terms "may" and "said stratum," whereas claim 6 of the '521 application does have those terms. Instant claim 130 is not directed to concentration ranges, whereas claim 130 of the '521 application is directed to a 480 to 600 g/l concentration range. Applicants therefore respectfully request withdrawal of the rejection of claims 6 and 130 under 35 U.S.C. §112, second paragraph.

III. Rejection under 35 U.S.C. §103(a)

Reconsideration is respectfully requested of the rejection of pending claims 3-6, 11-32, 67, 68, 70, 71, 73-76, 78, 79, 84-87, 89-92, 94, 95, 97, 98, 101-105, 108-123,

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[1] quoting MPEP 706.03(k).

128-130, 140-142, 146 and 147 under 35 U.S.C. §103(a). Applicants submit that those claims are patentable over the combined teachings of Ward et al. (US 6,093,681), Wright et al. (US 5,750,468), Suzuki et al. (US 6,313,074), Beestman et al. (US 4,159,901) and Turner[2].

A. The Present Invention

The applicants have discovered and disclosed that adding an enhancer compound in a pesticidally enhancing amount in excess of that required to neutralize metal ions in hard water can elicit a mechanism of action whereby the cell membrane permeability of plant cells is increased or enhanced expression of hydroxyproline-rich glycoproteins (HRGPs) enhances glyphosate movement to the phloem thereby increasing pesticide activity (see page 25, line 19 to page 25, line 27 and example 56 at page 211, lines 15-20). The increase is not caused by the ability of the enhancer compound to chelate calcium and other metal ions in hard water. In fact, in the case of oxalic acid, bioefficacy is significantly improved over conventional chelators such as EDTA or sodium citrate. The oxalic acid efficacy advantage over EDTA is present even though EDTA possesses a chelating capability about five orders of magnitude greater than oxalic acid (see Example 4 at page 109, lines 16-21 and Example 7 at page 116, lines 8-11). The addition of a relatively small amount of oxalic acid significantly reduces the amount of surfactant needed to provide a stable composition which, upon dilution and application to foliage of a plant, provides desired plant growth control. The invention enables minimization or elimination of surfactants from aqueous pesticidal compositions allowing preparation of stable glyphosate formulations, reduced aquatic toxicity and optimized product cost (see page 25, lines 2-25). It also significantly improves the performance of many surfactants which otherwise provide poor growth control, enabling the use of a broader range of surfactants in herbicidal formulations. The compositions are shown to be effective in controlling a broad spectrum of broadleaf plants including velvetleaf, sicklepod and morningglory.

B. The Pending Claims

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[2] Turner, D. J. "Effects on glyphosate performance, additives and mixing with other herbicides." *The Herbicide Glyphosate*, Chapter 15, pages 221-239 Grossbard et al., ed., Butterworths (1985).

Claims 3, 12, 17, 26 and 128 are each directed to glyphosate compositions comprising an enhancer compound which increases cell membrane permeability within the plant to increase cellular uptake of the pesticide in the plant as compared to similarly formulated compositions in which the enhancer compound is absent. In addition to the enhancer: Claim 3 requires an aqueous glyphosate concentrate and a surfactant wherein the weight ratio of the surfactant component to the enhancer compound is between about 5:1 and about 40:1; Claim 12 requires an aqueous glyphosate concentration exceeding 455 grams acid equivalent ("a.e.") per liter; Claim 17 requires an aqueous concentrate formed from a glyphosate salt selected from a Markush group that excludes the IPA salt; Claim 26 requires an aqueous concentrate formed from the potassium salt of glyphosate; and Claim 128 requires a solid herbicidal concentrate.

Claims 70, 75, 86, 89, 94, 97, 113, 123 are each directed to glyphosate compositions comprising oxalic acid or a salt thereof such that upon application to a broadleaf plant growth is controlled to a greater extent as compared to similarly formulated comparative compositions in which oxalic acid or a salt thereof is absent. In addition to oxalic acid or a salt thereof: Claim 70 requires an aqueous composition containing the potassium salt of glyphosate; Claim 75 requires an aqueous composition containing the diammonium salt of glyphosate; Claim 84 requires an aqueous composition containing a surfactant component; Claim 86 requires an aqueous composition containing a glyphosate concentration in excess of 360 g a.e./L and growth control exceeding that of comparative compositions instead containing EDTA or sodium citrate; Claim 89 requires an aqueous composition having a density of at least about 1.210 grams/L; Claim 94 requires an aqueous concentrate formed from a glyphosate salt selected from a Markush group that excludes the IPA salt; Claim 97 requires an aqueous composition having glyphosate a.e. and oxalic acid present in a weight ratio greater than 21:1; and Claims 113 and 123 each require an aqueous glyphosate concentrate and at least one surfactant selected from a Markush group.

Claims 101, 109 and 140 each directed to glyphosate concentrate compositions comprising an enhancer compound which increases expression of hydroxyproline-rich glycoproteins thereby increasing the movement of glyphosate in the plant phloem as compared to similarly formulated compositions in which the enhancer compound is absent. In addition to the enhancer: Claim 101 requires an aqueous concentrate and a surfactant wherein the weight ratio of the surfactant to the enhancer compound is between about 5:1 and about 40:1; Claim 109 requires an aqueous concentrate having

glyphosate concentration in excess of 455 g a.e./L; and Claim 140 requires a solid herbicidal concentrate.

Claim 84 is directed to an aqueous glyphosate composition containing oxalic acid and a surfactant component which when applied to the foliage of a susceptible plant provides growth rate reduction as compared to reference compositions containing ethoxylated (15 EO) tallowamine surfactant, cocoalkyltrimethylammonium chloride surfactant or POE(15) cocoalkylmonomethylammonium chloride surfactant.

Claim 118 is directed to a method of decreasing aquatic toxicity of aqueous glyphosate compositions without decreasing growth control by adding oxalic acid or a salt thereof to the compositions.

Claims 146 and 148 are each directed to solid pesticidal concentrates comprising a biologically effective concentration of a glyphosate salt or ester thereof and oxalic acid or a salt thereof. Claim 148 additionally requires a surfactant component.

C. The Cited Art

Ward discloses a method of applying a pesticide to a plant comprising contacting plant foliage with the pesticide and contacting the same foliage with a first amphiphilic excipient substance that forms anisotropic aggregates in or on a wax layer in the presence of a second excipient substance. Plant foliage comprises a surface waxy layer that serves as a barrier to insulate the plant from environmental insult. Pesticides must traverse that barrier to enter the plant. The anisotropic aggregates of Ward are self-assembled structures that affix to the external surface of the wax layer or form as structures within the wax layer thereby functioning as channels or bridges that provide a pathway for pesticidal wax layer traversal and subsequent entry into the plant (see, for example, column 10:5 to 11:32). Ward does not describe or suggest compositions containing glyphosate and oxalic acid, or any mechanism whereby glyphosate bioefficacy is improved by an enhancer compound (1) that increases cell membrane permeability within the plant to increase cellular uptake of the pesticide in the plant or (2) that increases expression of hydroxyproline-rich glycoproteins which increases movement of the pesticide to the plant phloem as is instantly claimed.

Wright describes compositions containing up to 500 g a.e./l glyphosate and etheramine surfactants. Solid compositions are not described. Wright does not describe or suggest any pesticidal compositions containing oxalic acid, or any pesticidal

composition containing an enhancer compound that (1) increases cell membrane permeability within the plant to increase cellular uptake of the pesticide in the plant or (2) increases expression of hydroxyproline-rich glycoproteins which increases movement of the pesticide to the plant phloem.

Suzuki describes nonionic alkoxylated alcohol agricultural chemical enhancers. Suzuki discloses at column 3:66 to 5:21 that chelating agents may be added to the enhancer with oxalic acid being but one example in a long list of chelators described at column 4:1-57; preferred chelators are not identified. Suzuki does not suggest that any pesticidal enhancement is achieved by adding chelators and is also silent regarding glyphosate concentrates. Working example 1, Table 3, is directed to tank mixes of IPA glyphosate and various components which are described in Table 2 with components 4, 5 and 18 being directed to EDTA (a tetra-carboxylic acid chelator) and component 9 being directed to NTA (a tri-carboxylic acid chelator). Working examples for di-carboxylic acids such as oxalic acid are not provided. Suzuki thus teaches away from the present invention and would have lead one of skill in the art to conclude that chelators having three or four carboxylic acid groups are preferred over di-carboxylic acids. This conclusion is contrary to Applicants' discovery.

Beestman describes adding oxalic acid to IPA glyphosate in tank mixes formed from hard water (i.e., water containing 2000 or more parts per million of calcium or magnesium ions) to **restore** the herbicidal activity lost by the presence of the ions. Described is an oxalic acid:ion weight ratio of 1:2 to 2:1. Thus Beestman describes the use of oxalic acid as a chelator to maintain herbicidal activity and does not disclose or suggest that herbicidal activity can be **increased** by oxalic acid as is instantly claimed. Beestman is devoid of any teaching or suggestion that oxalic acid can increase pesticide bioefficacy by (1) increasing cell membrane permeability within the plant to increase cellular uptake of the pesticide in the plant or (2) increasing expression of hydroxyproline-rich glycoproteins which increases movement of the pesticide to the plant phloem. Beestman generically describes various nonionic, cationic and anionic surfactants at column 3:18-63 that can be used in agricultural formulations, including ethoxylated monoamines, but does not describe surfactant concentrations thereby preventing surfactant to oxalic acid ratios from being determined. Moreover, Beestman is directed to tank mixes and does not provide any teaching regarding formulation of oxalic acid and surfactants in aqueous glyphosate concentrates or in solid compositions.

Turner (1985) discloses that glyphosate can be inactivated by many divalent and trivalent cations, such as by calcium ions in hard water. Turner further discloses that the addition of divalent and trivalent acids such as oxalic, citric, tartaric, phosphoric and lactic sequester (i.e. chelate) the ions to remove the antagonism. As with Beestman, Turner describes **restoring** the herbicidal activity lost by the presence of the ions, but in no way even suggests that dicarboxylic acids such as oxalic acid can **increase** herbicidal bioefficacy. Turner thus does not disclose or suggest that oxalic acid can increase glyphosate bioeffecacy by (1) increasing cell membrane permeability within the plant to increase cellular uptake of the pesticide in the plant or (2) increasing expression of hydroxyproline-rich glycoproteins which increases movement of the pesticide to the plant phloem. The *Agropyron repens* shoot growth control data reported by Turner in Table 15.4, page 230, indicates: that at a glyphosate application rate of 0.2 kg/ha orthophosphoric acid and oxalic acid provide similar control while tartaric acid gives about 40% greater control than oxalic acid; and at a glyphosate application rate of 0.4 kg/ha tartaric acid and oxalic acid give similar control. Applicants have further reviewed the Turner and Loader (1978) reference[3] from which the data of Table 15.4 was obtained. That reference at page 202, Table 1, discloses that at application rates of 0.2 kg/ha and 0.4 kg/ha oxalic acid and citric acid provide similar *Agropyron repens* rhizome control while phosphoric acid and tartaric acid give greater control than oxalic acid. Turner thus suggests that dicarboxylic acids provide similar or less glyphosate bioefficacy enhancement than do inorganic acids (e.g., phosphoric acid) and tricarboxylic acids (e.g., citric acid), a conclusion contrary to Applicants' discovery.

Turner (1985) at pages 229-230 describes the addition of oxalic acid to 2% concentration in ROUNDUP® (i.e. IPA glyphosate and surfactant) tank mixes but fails to disclose the glyphosate concentration, hence oxalic acid to surfactant ratios cannot be determined. To fill in this gap Applicants reviewed Tuner and Loader (1978) and calculated that the tank mixes described by that reference teach very high oxalic acid loading as represented by a surfactant ("S") to oxalic acid ("OA") weight ratio between

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[3] See D.J. Turner and M.P.C. Loader, *Complexing agents as herbicide additives* (1978), Weed Research 1978, Volume 18, 199-207. Submitted to the USPTO as reference number 68 in the IDS of February 16, 2002.

about 1:27 and about 1:54.[4] Pending claim 1 requires a glyphosate concentrate having a S:OA weight ratio between about 5:1 and about 40:1. Turner thus teaches a large excess by weight of oxalic acid while the pending claims require an excess by weight of surfactant. In fact, Turner's teaching of a S:OA weight ratio of 1:27 results in an oxalic acid concentration (wt% basis) relative to surfactant over 100 times greater than which results from the claimed ratio of 5:1. Applicants' discovery that glyphosate bioefficacy enhancement, as compared to mere restoration of herbicidal activity through ion chelation as described by Turner, can be achieved when surfactant is present in a weight excess over oxalic acid is surprising and unexpected.

Finally, Turner (1985) teaches away from the inclusion of chelating acids in glyphosate concentrates, and in particular at high S:OA weight ratio loading, by disclosing at page 230 that "[i]n practice these [i.e., acids] additives are difficult to use because they sometimes cause precipitation of glyphosate acid from concentrated spray solutions which can block spray nozzles." Thus Applicant's discovery that di-carboxylic acids can be incorporated in glyphosate concentrates is surprising and unexpected in view of Turner's teaching.

D. Patentability of the pending claims under 35 U.S.C. §103(a) over the cited art

The subject matter of a claim is *prima facie* obvious in view of particular references if the Office can demonstrate that (1) the references, alone or together, describe every element of the claims, (2) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references, and (3) there is some reasonable expectation of success.[5]

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[4] 0.2 kg glyphosate/ha ÷ 200 L/ha (see column 1 at page 201) x 1000 g/kg = 1 g/L ≈0.1% glyphosate a.i. ROUNDUP® has been described in the art to contain about 41% a.i. glyphosate IPA and about 15% by weight polyoxyethylene (15) tallowamine surfactant (see for example US 6,093,681 at column 37:45 to 38:32). By calculation, a ROUNDUP® tank mix containing 0.1% by weight glyphosate a.i. contains about 0.1 x 15/41 = 0.037 wt% surfactant. At a 2 wt% oxalic acid loading, a S:OA weight ratio of about 0.037:2 ≈ 1:54 results. A similar calculation for a 0.4 kg a.i./ha glyphosate tank mix gives a S:OA weight ratio of about 1:27.

[5]See MPEP § 2142.

As detailed in **III. C.** above, Applicants respectfully submit that Ward, Wright, Suzuki, Beestman and Turner references taken singly do not disclose or suggest each element of claims 3, 12, 17, 26, 70, 75, 84, 86, 89, 94, 97, 101, 109, 113, 118, 123, 128, 140 and 146, nor the claims that depend therefrom.

Moreover, as detailed in **III. C.**, the cited art taken collectively does not disclose or suggest a combination having the components of claims 3, 12, 17, 26, 70, 75, 84, 86, 89, 94, 97, 101, 109, 113, 118, 123, 128, 140 and 146, nor the claims that depend therefrom.

Ward and Wright only teach that glyphosate can be formulated with some of the instantly claimed surfactants, and those references are absolutely devoid of any teaching or suggestion that the herbicidal bioefficacy of those formulations can be enhanced with the instantly claimed enhancer compounds.

The teachings of Suzuki, Beestman and Turner would have lead one skilled in the art to believe that chelators other than dicarboxylic acids, such as citric acid, phosphoric acid or EDTA (which possesses significantly greater chelating ability than does oxalic acid) would produce the same or greater efficacy enhancing capabilities, and thus teach away from the present invention. To the contrary, at pages 25-26 of the instant specification, the applicants disclose that, for example, oxalic acid efficacy enhancement is not caused by its ability to chelate calcium or other metal ions in hard water. Unexpectedly, the applicants have discovered and disclosed in examples 4-9 at pages 108-119 that oxalic acid is a superior efficacy enhancer as compared to other dicarboxylic acids, and most surprisingly greater than EDTA (a tetracarboxylic acid). In particular, example 5 at pages 109-112 indicates that, on an equimolar basis, oxalic acid provides increased velvetleaf efficacy as compared to malonic, succinic, glutaric and adipic acid. Example 6 at pages 112-114 discloses that 0.6 w/v% (about 0.067M) oxalic acid gives more velvetleaf efficacy enhancement than does 2.0 w/v% (about 0.15M) IDA. Moreover, Example 7 at pages 114-116 indicates that 0.41 w/v% (about 0.025M) dipotassium oxalate provides greater efficacy enhancement than do 4.23 (about 0.14M) and 2.68 w/v% (about 0.10M) EDTA and sodium citrate, respectively. Thus the instantly claimed mechanisms of action fundamentally differ from the chelation mechanisms of Suzuki, Beestman and Turner. Such discoveries are contrary to the teaching of Suzuki, Beestman and Turner and would not have motivated one of skill in the art to combine those references with Ward and Wright.

The teachings of Suzuki, Beestman and Turner provide no teaching regarding liquid concentrate or solid compositions comprising glyphosate, a surfactant and a

dicarboxylic acid, and having a surfactant to dicarboxylic acid weight ratio between about 5:1 and about 40:1. Suzuki does not suggest that any pesticidal enhancement is achieved by adding chelators and is also silent regarding glyphosate concentrates. Beestman likewise fails to describe concentrates, describes chelation-mediated restoration of herbicide activity, and provides no guidance as to surfactant to dicarboxylic acid ratios. Turner also fails to describe concentrates and teaches low surfactant to dicarboxylic acid weight ratios (i.e., a dicarboxylic acid excess) between about 1:27 and 1:54 for the chelation-mediated restoration of herbicide activity, an amount described as being incompatible with glyphosate concentrates.

Without reference to the teaching of the instant invention, one would not have had a reasonable expectation of success in enhancing herbicidal bioefficacy by combining glyphosate with the claimed enhancers. Therefore, the combination of references, when viewed by one skilled in the art, would at best have been obvious to try, which without reasonable expectation of success is an improper standard for rejection under 35 U.S.C. §103(a). The courts have consistently held that the test for a *prima facie* case of obviousness is not whether an invention is obvious to try.[6] Instead, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references, and there must be some reasonable expectation of success. The Office has not met this legal standard.

The Office states that the motivating force for combining the references is "because they disclose the utility enhancing effects of additives in glyphosate compositions." A determination of obviousness requires evidence which establishes not merely what one skilled in the art might be led to attempt, but that she have a reasonable basis in the art for expecting to succeed. "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art as it existed at that time."[7] Moreover, it is improper to use the claims as a frame from which individual naked parts of separate prior art references may be employed as a mosaic to recreate the claimed invention.[8] The cited art is silent, and does not even suggest the glyphosate bioefficacy enhancing effect of the claimed compositions, much less the

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[6]See *In re O'Farrell*, 7 U.S.P.Q.2d 1673, 1680-81 (Fed. Cir. 1988).

[7]quoting *Interconnect Planning Corp. v. Feil* 227 USPQ 543 at 547 (Fed. Cir. 1985).

[8]Id. at 551.

compositions additionally requiring: concentrates having a weight ratio of surfactant to enhancer compound as required by claims 3 and 101; the weight ratio of glyphosate to oxalic acid as required by claim 97; glyphosate concentrations in excess of 455 g a.e./L as required by claims 12 and 109; glyphosate salts other than the IPA salt as required by claims 17, 26, 70, 75 and 94; a glyphosate concentration in excess of 360 g a.e./L and growth control exceeding that of comparative compositions instead containing EDTA or sodium citrate; glyphosate compositions containing oxalic acid and a surfactant component which when applied to the foliage of a susceptible plant provides growth rate reduction as compared to reference compositions containing ethoxylated (15 EO) tallowamine surfactant, cocoalkyltrimethylammonium chloride surfactant or POE(15) cocoalkylmonomethylammonium chloride surfactant as required by claim 84; a composition density greater than 1.210 as required by claim 89; a glyphosate a.e. to oxalic acid weight ratio exceeding 21:1 as required by claim 97; a glyphosate concentrate and one or more surfactants as required by claims 113 and 123; and solid glyphosate compositions as required by claims 128, 140, 146 and 148. The law requires not merely a rational hope, but a concrete basis to expect success. Applicants therefore respectfully submit that the cited art, singly or in combination, provides no teaching, motivation or suggestion for the claimed compositions.

E. Conclusion

For the foregoing reasons, it is respectfully submitted that the Office has failed to establish that claims 3, 12, 17, 26, 70, 75, 84, 86, 89, 94, 97, 101, 109, 113, 118, 123, 128, 140 and 146, nor the claims that depend therefrom, are *prima facie* obvious in view of Ward, Wright, Suzuki, Beestman and Turner. Therefore, Applicants submit that claims 3-32, 67, 68, 70, 71, 73-76, 78, 79, 84-87, 89-92, 94, 95, 97, 98, 101-123, 128-130, 140-142 and 146-148 meet the requirements under 35 U.S.C. §103(a) and are in condition for allowance.

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Enclosed is a check in the amount of $110.00 for the purchase of a one-month extension of time under 37 C.F.R. §1.136(a). The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 19-1345.

Respectfully submitted,

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